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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,812	02/24/2004	Mark Hockman	P07698US00/WEJ	1182

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EXAMINER

CHAPMAN, JEANETTE E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,812	HOCKMAN, MARK	
	Examiner	Art Unit	
	Chapman E. Jeanette	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

- I. claims 1-6, drawn to the combination metal standing seam roof and the snow guard, classified in class 52, subclass 24
- II. claims 7-8, drawn to the method of mounting a decorative snow guard assembly, classified in class 52, subclass 741.1

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process can be used with a product having additional features or limitations over and besides those claimed in group I.

During a telephone conversation with Mr. Jackson on 3/22/06 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-8 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-6 (is/are) rejected under 35 U.S.C. 103(a) as being unpatentable over Trevorrow (6834466) in view of Hockman (6499259).

Trevorrow discloses a combination metal standing seam roof and a snow guard assembly comprising:

1. the roof comprising:
 - a. first and second roofing panel 16
 - b. each having a perpendicular longitudinal edge and the longitudinal edges are in close proximity to each other to form a raised seam10., see figure 5.
2. an aesthetically pleasing snow brake 4, column 6, lines 40-53, integral with a base which defines a groove 22 whereby the base is located on the metal roof by the placement of the groove about the segment of the seam
3. the improvement comprising:
 - a. spanning means 6/8 extending between adjacent snow brake means
 - b. fastening means on the base 54-58/44 for connecting the base with

the spanning means: the means comprising

- i. bosses/bolts 54-58 extending outwardly from the outer side surfaces of the base and the bosses located near the surface of the roof whereby the spanning means is connectable to the bosses adjacent the snow brakes; see figure 5; alternatively stated, a bolt threaded through a hole defined in the wall of the base; see figures 5 and 6
- ii. depressions 44 formed on the outer side surfaces; the spanning means fits into the depressions whereby the spanning means is connectable into said depressions on adjacent snow brakes.

Though the term decorative is broad and relative and some may find the transparent nature of Trevorrow decorative, some may argue that the snow brake of Trevorrow is not decorative. Hockman shows a decorative snow brake. It would have been obvious to one of ordinary skill in the art to modify Trevorrow to decorate the snow brake similar to that of Hockman in order to add aesthetic appeal to the building structure.

Trevorrow lacks the groove that has at least one wall shaped to interlock with a lower edge of the raise seam as that taught by the raised seam and groove of Hockman. It would have been obvious to one of ordinary skill in the art to modify Trevorrow to include the shaped wall to interlock with the raised seam to provide a stronger attachment of the snow guard to the seam as shown by Hockman.

Claims 4 (is/are) rejected under 35 U.S.C. 103(a) as being unpatentable over Trevorrow in view of Hockman in view of Alley (6536166) and Van der Wyk (4593877). As stated before the spanning means comprises a pipe and the hollow end of the pipe slidably fits over the bosses 54-56 on the bases. The hollow end is only located near the end of the bosses 54-56. Some may argue that the spanning means is not a pipe wherein the hollow end of the pipe slidably fits over the bosses. Van der Wyk discloses a brake or support with openings to accommodated a pipe 32. Alley discloses a snow brake and pipes used in connection with the snow brake. It would have been obvious to one of ordinary skill in the art to modify Trevorrow to include pipes in stead of bars 6/8 to lighten the weight of the support structure on the roof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEANETTE E. CHAPMAN
PRIMARY EXAMINER
ART UNIT 3635
